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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,275	04/13/2004	Magnus Svensson	PS03 0296US1	3485
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WARREN A. SKLAR (SOER)			EXAMINER	
RENNER, OTTO, BOISSELLE & SKLAR, LLP			BELANI, KISHIN G	
1621 EUCLID AVENUE				
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CLEVELAND, OH 44115			PAPER NUMBER	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/823,275

Applicant(s)

SVENSSON ET AL.

Examiner

Kishin G. Belani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/30/2004</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement submitted on 06-30-2004 has been considered by the Examiner and made of record in the application file.

### ***Specification***

The disclosure is objected to because of the following informalities:

On page 7, line 1; delete "automatically".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 3, 5 and 7-11** are rejected under 35 U.S.C. 102(e) as being anticipated by **Nielson et al. (US Patent Application Publication # US 2006/0129643 A1)**.

Consider **claim 1**, Nielson et al. disclose a multimedia-messaging-capability-negotiation method (paragraphs 0027-0031 that disclose a method whereby an instant messaging client originates and receives instant messages (in paragraph 0027), obtains presence information associated with a target user/terminal from the server (in paragraph 0028), using Subscribed Presence Transaction (in paragraph 0029) or Get Presence transaction (in paragraph 0030) and analyzing the response returned by the server (in paragraph 0031) to determine which options (including message type, e.g. a telephone call, SMS or MMS) are better suited to communicate with the target user/terminal) comprising:

receiving, by a first service, of multimedia-messaging-capability information from a receiving client (paragraph 0002 that discloses using the Wireless Village (WV) protocol by a first service for Instant Messaging and Presence Services (IMPS); paragraph 0003 which discloses that Presence Attributes allow a user (a receiving client) to publish attribute information about the user or their terminal, so that other IMPS clients (a sending client) can obtain the attribute information and be informed of changes to the information; paragraph 0023 discloses additional details about a receiving client);

transmitting, by the first service, of the multimedia-messaging-capability information to a sending client (paragraphs 0028-0031 that disclose the process of transmitting the

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multimedia-messaging-capability information of a receiving client from the server of the first service to a sending client); and

evaluating the multimedia-messaging-capability information by the sending client in order to determine what further action to take relative to communicating with the receiving client (paragraph 0069, lines 2-20 that describe different multimedia-messaging-capability options provided by the server that a sending client has to evaluate before sending a message to a receiving client, such as a telephone call, an instant messaging session, etc.).

Consider **claim 3**, and **as it applies to claim 1 above**, Nielson et al. disclose the claimed method, further comprising opting, by the sending client, to not send a message to the receiving client (paragraph 0072 that discloses different options the sending client may select from, based on the presence information of the receiving client, including not to send a message to the receiving client).

Consider **claim 5**, and **as it applies to claim 1 above**, Nielson et al. disclose the claimed method, wherein the first service operates in accordance with Wireless Village protocol (WV) (paragraphs 0002, 0004 and 0023 which disclose that the first service uses Wireless Village protocol (WV)).

Consider **claim 7**, and **as it applies to claim 1 above**, Nielson et al. disclose the claimed method, wherein the multimedia-messaging-capability information indicates that

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the receiving client is adapted to receive multimedia messages (paragraph 0031 that discloses "Preferred Contact" which indicates the preferred method of contact for the receiving client, e.g. call, SMS, MMS, IM and email, thereby disclosing that the receiving client is adapted to receive multimedia messages).

Consider **claim 8**, and **as it applies to claim 7 above**, Nielson et al. disclose the claimed method, wherein the message is in accordance with MMS (paragraph 0031 that discloses "Preferred Contact" which indicates the preferred method of contact, e.g. call, SMS, MMS, IM and email, thereby disclosing that the message is in accordance with MMS).

Consider **claim 9**, and **as it applies to claim 1 above**, Nielson et al. disclose the claimed method, wherein the multimedia-messaging-capability information indicates that the receiving client is not adapted to receive multimedia messages (paragraph 0072 that discloses certain communication options being available while others may not, depending on the presence information of the receiving client; e.g. lines 4-9 describe telephone call as the contact option at the exclusion of other options including IM and MMS).

Consider **claim 10**, and **as it applies to claim 9 above**, Nielson et al. disclose the claimed method, wherein the message is in accordance with short messaging service (SMS) (paragraph 0072 that discloses certain communication options being

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available while others may not, depending on the presence information of the receiving client; e.g. lines 14-20 describe SMS as the contact option if the receiving client is not currently available).

Consider **claim 11**, and **as it applies to claim 1 above**, Nielson et al. disclose the claimed method, wherein the multimedia-messaging-capability information is included in a WV extension field for presence attributes for the receiving client (paragraph 0064 which discloses that the presence indicator may be an indication of the "registration" presence attribute for the receiving client that uses Wireless Village protocol to register with the first service).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness

or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 2, 4, 6 and 12-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nielson et al. (US Patent Application Publication # US 2006/0129643 A1)**, in view of **Coulombe (U.S. Patent Publication # 7,103,681 B2)**.

Consider **claim 2**, and **as it applies to claim 1 above**, Nielson et al. disclose the claimed method, including wherein the message is adapted by the sending client in accordance with the multimedia-messaging-capability information (paragraph 0031 that discloses multimedia-messaging-capability information of the receiving client; paragraphs 0064 and 0069 that disclose how the sending client should adapt the message based on the capability of the receiving client).



However, Nielson et al. do not disclose that the method further comprises transmitting, by a second service, of a message from the sending client to the receiving client.

In the same field of endeavor, Coulombe does show and disclose that the method further comprises transmitting, by a second service, of a message from the sending client to the receiving client (Fig. 1, a second service MMSC 14, multi-media message signal MMSS 20 and receiving terminal 22; column 1, lines 36-38 which disclose that MMSC tries its best to adapt each media component to a format that is supported by the receiving terminal based on the reported capabilities of the terminal).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to transmit, by a second service, of a message from the sending client to the receiving client, as taught by Coulombe, in the method of Nielson et al., so that the receiving terminal is still able to view the content of the transmitted message despite its limited capabilities.

Consider **claim 4**, and **as it applies to claim 2 above**, Nielson et al., as modified by Coulombe, disclose the claimed method, including wherein the second service operates in accordance with multimedia messaging services (MMS) (in Coulombe reference, Fig. 1, Multimedia Messaging Service Center (MMSC) 14; column 4, lines 43-46 that disclose the details of the MMS service).

Consider **claim 6**, and **as it applies to claim 2 above**, Nielson et al., as modified by Coulombe, disclose the claimed method, including wherein the first service operates in accordance with WV; and the second service operates in accordance with MMS (in Nielson et al. reference, paragraphs 0002, 0004 and 0023 which disclose that the first service operates in accordance with WV (Wireless Village protocol); in Coulombe reference, Fig. 1, Multimedia Messaging Service Center (MMSC) 14; column 4, lines 43-46 which disclose that the second service operates in accordance with MMS).

Consider **claims 12**, and **as it applies to claim 1 above**, Nielson et al., as modified by Coulombe, further disclose the claimed method, wherein the multimedia-messaging-capability information is included in a user agent profile (UAprof) link in an information presence attribute of the receiving client (in Coulombe reference, column 1, lines 23-25 which disclose that the multimedia-messaging-capability information is obtained through a user agent profile (UAprof) link of the receiving client).

Consider **claims 13**, and **as it applies to claim 1 above**, Nielson et al., as modified by Coulombe, further disclose the claimed method, wherein the multimedia-messaging-capability information is included in a UAprof element of a client information element of the receiving client (in Coulombe reference, column 1, lines 23-25 which disclose that the multimedia-messaging-capability information is deduced from HTTP/WSP headers such as a User Agent header (UAHEADER in a UAprof element) of the receiving client).

Consider **claims 14**, Nielson et al., disclose an end-to-end multimedia-messaging-capability-negotiation system (paragraphs 0027-0031 that disclose a system whereby an instant messaging client originates and receives instant messages (in paragraph 0027), obtains presence information associated with a target user/terminal from the server (in paragraph 0028), using Subscribed Presence Transaction (in paragraph 0029) or Get Presence transaction (in paragraph 0030) and analyzing the response returned by the server (in paragraph 0031) to determine which options (including message type, e.g. a telephone call, SMS or MMS) are better suited to communicate with the target user/terminal) comprising:

a WV service (paragraph 0002 that discloses using the Wireless Village (WV) protocol by a first service for Instant Messaging and Presence Services (IMPS)), wherein the WV service is adapted to:

receive multimedia-messaging-capability information from a receiving client (paragraph 0003 which discloses that Presence Attributes allow a user (a receiving client) to publish attribute information about the user or their terminal, so that other IMPS clients (a sending client) can obtain the attribute information and be informed of changes to the information; paragraph 0023 discloses additional details about a receiving client); and transmit the multimedia-messaging-capability information to a sending client (paragraphs 0028-0031 that disclose the process of transmitting the multimedia-messaging-capability information of a receiving client from the server of the first service to a sending client); and

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wherein the message is adapted by the sending client in accordance with the multimedia-messaging-capability information (paragraph 0031 that discloses multimedia-messaging-capability information of the receiving client; paragraphs 0064 and 0069 that disclose how the sending client may adapt the message based on the capability of the receiving client).

However, Nielson et al. do not disclose that the system further comprises an MMS service, wherein the MMS service is adapted to transmit a message from the sending client to the receiving client.

In the same field of endeavor, Coulombe does show and disclose that the system further comprises an MMS service, wherein the MMS service is adapted to transmit a message from the sending client to the receiving client (Fig. 1, a second service MMSC 14, multi-media message signal MMSS 20 and receiving terminal 22; column 1, lines 36-38 which disclose that MMSC tries its best to adapt each media component to a format that is supported by the receiving terminal based on the reported capabilities of the terminal).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide an MMS service, wherein the MMS service is adapted to transmit a message from the sending client to the receiving client, as taught by Coulombe, in the system of Nielson et al., so that the receiving terminal is still able to view the content of the transmitted message despite its limited capabilities.

Consider **claim 15**, and **as it applies to claim 14 above**, Nielson et al., as modified by Coulombe, further disclose the claimed system, wherein the sending client may, responsive to receipt of the multimedia-messaging-capability information, opt to not send a message to the receiving client (in Nielson et al. reference, paragraph 0072 that discloses different options the sending client may select from, based on the presence information of the receiving client, including not to send a message to the receiving client).

Consider **claim 16**, and **as it applies to claim 14 above**, Nielson et al., as modified by Coulombe, further disclose the claimed system, wherein the multimedia-messaging-capability information indicates that the receiving client is adapted to receive multimedia messages (in Nielson et al. reference, paragraph 0031 that discloses "Preferred Contact" which indicates the preferred method of contact for the receiving client, e.g. call, SMS, MMS, IM and email, thereby disclosing that the receiving client is adapted to receive multimedia messages).

Consider **claim 17**, and **as it applies to claim 14 above**, Nielson et al., as modified by Coulombe, further disclose the claimed system, wherein the multimedia-messaging-capability information indicates that the receiving client is not adapted to receive multimedia messages (in Nielson et al. reference, paragraph 0072 that discloses certain communication options being available while others may not, depending on the presence information of the receiving client; e.g. lines 4-9 describe

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telephone call as the contact option at the exclusion of other options including IM and MMS).

Consider **claim 18**, and **as it applies to claim 17 above**, Nielson et al., as modified by Coulombe, further disclose the claimed system, wherein the message is in accordance with Short Messaging Service (SMS) (in Nielson et al. reference, paragraph 0072 that discloses certain communication options being available while others may not, depending on the presence information of the receiving client; e.g. lines 14-20 describe SMS as the contact option if the receiving client is not currently available).

Consider **claim 19**, and **as it applies to claim 14 above**, Nielson et al., as modified by Coulombe, further disclose the claimed system, wherein the multimedia-messaging-capability information is included in a WV extension field for presence attributes for the receiving client (in Nielson et al. reference, paragraph 0064 which discloses that the presence indicator may be an indication of the "registration" presence attribute for the receiving client that uses Wireless Village protocol to register with the first service).

Consider **claims 20**, and **as it applies to claim 14 above**, Nielson et al., as modified by Coulombe, further disclose the claimed system, wherein the multimedia-messaging-capability information is included in a user agent profile (UProf) link in an information presence attribute of the receiving client (in Coulombe reference, column 1,

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lines 23-25 which disclose that the multimedia-messaging-capability information is obtained through a user agent profile (UAprof) link of the receiving client).

Consider **claims 21**, and **as it applies to claim 14 above**, Nielson et al., as modified by Coulombe, further disclose the claimed system, wherein the multimedia-messaging-capability information is included in a UAprof element of a client information element of the receiving client (in Coulombe reference, column 1, lines 23-25 which disclose that the multimedia-messaging-capability information is deduced from HTTP/WSP headers such as a User Agent header (UAHEADER in a UAprof element) of the receiving client).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent: 7,181,537 B2, inventor: Costa-Requena et al., issued: 02/20/2007

US Patent Application Publication 2006/0014552 A1; by Cunningham et al.;  
filed 3/28/2005

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents  
P.O. Box 1450  
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**Hand-delivered responses** should be brought to

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Randolph Building  
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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kishin G. Belani whose telephone number is (571) 270-1768. The Examiner can normally be reached on Monday-Thursday from 6:30 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-0800.



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*Kishin G. Belani*

K.G.B./kgb

September 6, 2007

  
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